

REMARKS

Upon entry of this Amendment, claims 1-50 are all the claims pending in the application. Claims 44-50 have been added to provide additional claim scope. No new matter has been added. Claims 1-43 presently stand rejected.

§112 Rejections and Claim Objections

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure which is not enabling.

Claims 2, 3, 7 and 17 are rejected under 35 U.S.C. § 112, second paragraph, for being indefinite.

Claims 2-5, 17 are objected to because they recite a limitation of claim 1, of which there is insufficient antecedent basis for this limitation.

Claim 8 is *objected* to as being indefinite.

Claim 32 is rejected under 35 U.S.C. § 112, first paragraph.

§102 Rejection

Claims 1, 7, 9, 12, 13, 15, 17, 19-21, 23-33, 35-38 and 40-43 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shaffer et al. (6,381,324).

§ 103 Rejections

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 1, and in view of S. Shaffer et al. (5,950,165)

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 1, and in view of Skladman et al. (6,438,215).

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 1, and further in view of Porter (6,282,270).

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 1, and further in view of Cheston et al. (6,330,308).

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 9, and further in view of S. Shaffer et al. (5,950,165).

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 9, and further in view of Swan et al. (6,351,222).

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 9, and further in view of Dauerer et al. (6,311,177).

Claims 34 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (6,381,324) as applied to claim 33, and further in view of Vystosky et al. (5,719,921).

For the following reasons, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

Applicant's Response in Regard to the §112 Rejections and Claim Objections

In regard to claim 1, Applicant submits that the claim language, both as originally presented as well as subsequent to entry of this Amendment, satisfies each requirement of 35 U.S.C. § 112. In particular, the Examiner pointed out that a portion of the language recited in claim 1, in particular, "converted telephone number form of said telephone number," is different than a certain passage from the specification, i.e., at page 3, line 22. In response, Applicant

points out that the claim has been broadened to recite the “converted form of the new contact name” as opposed to a “converted telephone number”. Further, Applicant submits that the addition of this limitation is fully supported by the specification as originally filed.

In regard to claims 2, 3, 7 and 17, Applicant submits that each of these claims, as presently presented, satisfies the requirements of §112.

In regard to claims 2-5 and 17, as being objected to because they recite a limitation of claim 1, of which there is insufficient antecedent basis for this limitation, Applicant submits that each of the limitations in these claims now has proper antecedent basis.

In regard to the rejection of claim 8, Applicant has amended the claim to remove the reference to “any other”.

For at least the reasons set forth above, Applicant submits that each of the rejections under 35 U.S.C. §112, as well as the claim objections, should be withdrawn.

Applicant’s Response in Regard to the Prior Art Rejections

In regard to the rejection of claim 1 under 35 U.S.C. §102 as being anticipated by Shaffer et al. (‘324), Applicant submits that the asserted prior art reference fails to teach at least the claimed comparison unit and the claimed textual directory unit. In particular, the invention disclosed and claimed in the present application includes a method of, and device for, converting a verbal, or spoken, form of a new contact name (and/or number in some embodiments) to a text form of that name or number. The text form of the name or number is then compared to data in a stored directory and a communications network, such as the Internet or some other network or directory, is searched in order to locate new contact data associated with the new name and/or

number. When new contact data is selected, that data is then entered into the personal address book of the user. To that end, claim 1 recites, *inter alia*:

a comparison unit operable to compare the converted text form of the new contact name with a plurality of text entries in the at least one stored textual directory; and
a textual directory unit for searching the electronic communications network to locate the contact data based on the converted form of the new contact name, wherein the selected contact data is inserted into the personal address book associated with the user.

The Examiner asserts that Shaffer et al. teaches the claimed comparison unit at item 612 in Fig. 12 and the claimed textual directory unit at column 21, line 11 and column 14, line 46.

Applicant disagrees with the Examiner's interpretation of the cited portions of Shaffer et al. and, further, Applicant submits that the system disclosed in Shaffer et al. is completely different than the system and method disclosed and claimed in the present application. Specifically, at box 612 of Fig. 12, Shaffer et al. discloses a comparison between "LERG_LISY(K)" and "DPV_TELE#". The Examiner asserts that "DPV_TELE#" is the "converted text" and that "LERG_LISY(K)" is the claimed "text entry" of the directory. The Examiner's interpretation of Shaffer et al., however, is unsupportable from the Shaffer et al. specification. First, it is pointed out that the claim has been amended to recite "converted text form of the new contact *name*". It is clear that "DPV_TELE#" does not represent a *name* as required by the claim.

Furthermore, there is no disclosure in Shaffer et al. that supports the assertion that "DPV_TELE#" is a *converted text form* of any data associated with a "new contact". The DPV

file appears to contain telephone numbers from a “data provider” and these numbers are sequentially compared to a list of all potential numbers (i.e., LERG file) connected to a particular switch within the telephone system (see, e.g., col. 45, lines 31-45). Therefore, at least because Shaffer et al. fails to teach a comparison between names and, moreover, a comparison between a converted text form of a new contact name with a list of names stored in a directory, Shaffer et al. does not, and can not, teach the comparison unit as recited in claim 1.

Additionally, Shaffer et al. does not teach or suggest the claimed textual directory unit and all the limitations included therein. Specifically, Shaffer et al. does not disclose any device operable to search an electronic communications network to locate contact data *based on the converted form of the new contact name*. Again, as stated above, Shaffer et al. does not disclose using a text form of a new contact name, which has been converted to text form from a verbalized form of the new contact name, for searching an electronic communications network for new contact data, as claimed. For this additional reason Shaffer et al. does not, and can not, anticipate the invention recited in claim 1.

For similar reasons as those set forth above in regard to claim 1, Shaffer et al. does not teach, or suggest, the invention recited in claim 9. Claim 9 recites, *inter alia*:

- recording the pronunciation of the name of the new contact by the user over the user’s telephone;
- obtaining the telephone number of the new contact;
- searching said at least one textual directory for at least one telephone number matching the telephone number of said contact;
- obtaining at least one name associated with each of at least one matching telephone number;
- loading said ASR with said at least one associated name;

determining using ASR whether said at least one associated name matches said pronounced name; and
entering said matching name and textual data associated with said matching name into said PAB.

According to the embodiment recited in claim 9, the name of a new contact name is recorded and a telephone number associated with that name is then obtained. The textual directory is then searched to locate at least one telephone number matching the number associated with the new contact name and at least one name associated with that found number is then obtained. By loading the obtained name that corresponds to the found number into an automatic speech recognizer (ASR), it then can be determined whether the name obtained through the search sounds like, or matches, the originally recorded name of the new contact. If the names match, the obtained name and various textual data associated with that obtained name are recorded in the user's PAB. These various features are simply not disclosed in Shaffer et al. Even if Shaffer et al. were to disclose the use of Voice Response Units (VRU) utilizing speech recognition (e.g., col. 2, lines 50-55) and textual searching in various directories (e.g., col. 5, lines 7-11), Shaffer et al. does not disclose all the features recited in claim 9 and for the certain features that might be recited, as mentioned above, these features are not *arranged as in the claim*. Accordingly, Shaffer et al. does not anticipate claim 9 and the rejection should be withdrawn.

Also, for similar reasons as those set forth above in regard to claim 9, Shaffer et al. does not teach, or suggest, the invention recited in either claim 29 or claim 36. In particular, Shaffer fails to teach recording a first identifying information or a pronunciation thereof, of the new contact; obtaining second identifying information, different than the first identifying information,

corresponding to the new contact; using the second identifying information and the recorded first identifying information, or the pronunciation thereof, to select an entry in a directory; and storing the selected entry in the address book, as specifically recited in the claim.

Accordingly, Shaffer et al. does not anticipate claim 29 or claim 36 and the rejection of these claims should be withdrawn.

For at least the reasons set forth above, each of independent claims 1, 9, 29 and 36 distinguishes over the cited reference, Shaffer et al. ('324) and, thus Shaffer et al. does not anticipate these claims. Furthermore, at least based on their dependency from claims 1, 9, 29 and 36, claims 2-8, 10-28, 30-35 and 37-43, respectively, are patentable over the cited prior art as well, either cited alone or in any reasonable combination.

Patentability of New Claims

For additional claim coverage merited by the scope of the invention, Applicant has added new claims 44-50. Applicant submits that the prior art does not disclose, teach, or suggest the combination of features contained therein.

Conclusion

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-50, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/774,088

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kevin M. Barner
Registration No. 46,075

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: June 13, 2003

Attorney Docket No.: Q61007